

No. 14399

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

J. & H ELECTRIC COMPANY, a corporation,

Appellant,

vs.

M. STEPHENS MFG., INC., a corporation, and JACK Mc-
LOUGHLIN, doing business as McLoughlin Sales,

Appellees.

APPELLANT'S OPENING BRIEF.

MASON & GRAHAM,
COLLINS MASON,
WILLIAM R. GRAHAM,
811 West Seventh Street,
Los Angeles 17, California,
Attorneys for Appellant.

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PAUL P. O'BRIEN,
CLERK



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This is an appeal by the plaintiff below from that part of the District Court judgment [R. 27] which held that the appellees, defendants below, had not infringed the single claim of United States Letters Patent in suit No. 2,475,322 [Ex. 1, R. 189]. The judgment also held the patent to be valid. Appellees have not appealed from that portion of the judgment.

The sole issue involved in this appeal is, therefore, whether the judgment of non-infringement is erroneous; and determination of this issue depends upon whether or not the expression "*substantially at right angles to the major axis*," in the patent claim, must be construed as excluding a slight variation of from 1° to 5° from the right angular.

Statement of Jurisdiction.

This action arises under the patent statutes of the United States [Complaint, R. 3], which is admitted by the defendants [Answer, R. 9]. The District Court's judgment was entered March 9, 1954 [R. 27], and appellant's notice of appeal was filed March 8, 1954 [R. 28]. Jurisdiction of the District Court is founded on Title 28, Section 1338, of the United States Code and jurisdiction of this Court of Appeals is founded upon Title 28, Section 1292(4) of the United States Code.

Statement of the Case.

The patent in suit is for a coupling device used in connecting spiraled flexible conduits (which carry electrical wires) to junction boxes.

Prior to the invention of the patent in suit, coupling devices for this purpose employed *threads which mated* with the spiraled grooves of the conduits. The coupling was simply screwed into the conduit and, to prevent the conduit from escaping from the coupling, either clamping rings were used, or setscrews were threaded through the coupling to bear against the conduit, or a collar was used to bear against and deform the inner end of the conduit. Such prior devices are exemplified by physical Exhibits 8, 9 and 12. Those prior devices, however, gave trouble because the connections would vibrate loose [R. 42, 44, 46] and they presented difficulties in locking the conduit to the coupling device when the latter was mounted in an inaccessible place [R. 44].

The coupling device of the patent in suit overcame those difficulties by using, instead of mating threads, some longitudinally spaced *ribs* arranged in two diametrically opposed groups, and being disposed *substantially* at right

angles to the major axis of the coupling, *the ribs of one group being so staggered relative to the ribs of the other group as to define a spiral whose helical angle is greater than the helical angle formed by the convolutions of the conduit*. In the drawing on page 8 of this brief, this helical angle is illustrated by a diagonal line intersecting one of the upper ribs and the next contiguous lower rib.

By providing such ribs, and so arranging them *relative to each other and relative to the spiral convolutions of the conduit*, it is possible, by relative rotation of the conduit and coupling device, easily to insert the coupling device in the end of the conduit; but, if an attempt is made to remove the device from the conduit by rotation in the opposite direction, the ribs “jam” or grip against the inner surface of the conduit, thus locking the parts together until forcibly separated by a suitable tool [see Column 3, lines 21-57 of the specification of the patent in suit, R. 189].

Appellant (assignee of the patent in suit) has made and sold the patented coupling device since 1946 [R. 40], having sold over four million of them up to the time of trial [R. 50]. Specimens of appellant’s said devices are in evidence as Exhibits 2, 3, 4 and 5. Specimens of the standard flexible conduit are in evidence as Exhibits 13-16, inclusive. It will be seen that each conduit is formed of a strip of metal spirally wound to form spiraled grooves in the nature of threads.

Appellees commenced the alleged infringement in 1951 [R. 105], after seeing appellant’s devices [R. 123]. Exemplars of the accused devices are in evidence as Exhibits 17-22, 33, 34, inclusive.

Appellees base their contention of non-infringement upon the proposition that the patent claim recites that the ribs

of the coupling are disposed “substantially at right angles to the major axis” of the coupling, and that [except as to Ex. 17] appellees avoid the patent claim by disposing the ribs of the accused devices at an angle to the major axis which varies from the right angular only by from one degree in the smallest device to five degrees in the largest device. Appellees urge, in support of this contention, that appellant is estopped by “file wrapper estoppel” to assert that the patent claim covers any coupling device in which the ribs are not disposed *precisely* at right angles (90°) to the major axis of the device [*Findings VIII*, R. 22 and *XII*, R. 25].

As to the accused device of Exhibit 17, appellees concede that the ribs are disposed precisely at right angles to the major axis [Finding XI, R. 24], but, despite the fact that appellant purchased Exhibit 17 in the open market [R. 138], appellees contend that, while they made the devices of Exhibit 17, they passed them out to the trade as samples, and did not sell them.

It is appellant’s contention that there is no such “file wrapper estoppel,” that such an inconsequential variation in the disposition of the ribs from the right angular is embraced within the language “*substantially* at right angles,” and that, in any event, the claim is entitled to such reasonable interpretation under the *doctrine of equivalents*. It is also appellant’s contention that Exhibit 17 should have been adjudged to be an infringement and its further manufacture enjoined, whether or not the accused devices of that construction were sold.

Appellees have failed to produce any prior art which was not cited and considered by the Patent Office during prosecution of the application for the patent, and in none of that art is there any showing or suggestion of the

construction claimed by the patent in suit. On the contrary, the prior art merely discloses couplings having threads, some mutilated and some continuous, which *mate with the convolutions of the conduit*, so that they can be screwed into the conduit *or unscrewed* therefrom with equal ease.

It is submitted that no inference unfavorable to the patent can flow from the fact that the patent contains but a single claim, because the patented device is of simple construction and is amply defined by the single claim. The patent application originally contained several claims, directed to several different species of the invention but, upon requirement by the Patent Office for division, the application was confined to the one species of the patent claim.

There is no conflict in the testimony as to any material matter. Appellant's expert testified that the accused devices are, in every material respect, identical with the structure claimed in the patent [R. 86, 87] and operate in the same manner [R. 91]. The only witness produced by appellees was a Mr. Friedman, an officer of appellee Stephens [R. 110], who did not contradict appellant's expert. He did testify that the ribs of the accused devices provide a "better grip" because they are *thicker* or more raised than the ribs on appellant's commercial couplings [R. 111, 112], but *the patent contains no limitation as to the thickness of the ribs*. Moreover, he testified that he was not an engineer, and confessed that he could only venture an assumption as to how the accused device operates [R. 122-123].

Therefore it cannot be said that the judgment of non-infringement was arrived at by resolving any conflict of testimony. From the findings [R. 19] and the oral opin-

ion of the trial judge [R. 167], it appears that the trial judge arrived at the judgment from his own examination of the file wrapper of the patent in suit [Ex. D], *which is before the Court in this appeal for independent interpretation by this Court*. It is appellant's contention that there is nothing in the file wrapper, or in the patent in suit, which shows or indicates that, in using the term "substantially at right angles" in the patent claim, the patentees intended to exclude any structure in which the ribs vary from the right angular by such an inconsequential amount as one to five degrees.

The Findings of Fact.

Findings I and II are merely jurisdictional. Finding III is immaterial to the judgment since the patent was found to be valid. Findings IV and V merely describe the patent in suit. Findings VI and VII are immaterial to the judgment since the patent was found valid.

The only findings which, if supported by the evidence, would be material to the judgment, are VIII, IX, X, XI, XII and XIII, which will be hereinafter analyzed. It is appellant's position that not only are those findings not supported by the evidence, but that they are directly contrary to the evidence and law.

Specification of Errors.

It is appellant's contention that the District Court erred in each of the following respects:

1. In holding that appellees have not infringed the patent in suit [Pars. 1, 2, 4, 5, 6, 7 of Statement of Points on Appeal; R. 185].

2. In holding that the word "substantially" in the patent claim is not to be interpreted to include a varia-

of 1° to 5° [Findings VI, R. 21, VIII, R. 22 and I R. 25, and Pars. 4-7 of Statement of Points].

In holding that, by virtue of the proceedings in the Patent Office during the prosecution of the application for patent in suit, the patentees estopped themselves from contending that the term "substantially at right angles to major axis," can be construed as covering a slight variation from the right angular of from 1° to 5° , which variation produces no change in operation [Findings VI, R. 21, VIII, R. 22 and XII, R. 25], and Par. 5 of Statement of Points.]

4. In finding that the outside diameter of appellees' coupling is greater than the inside diameter of the normal conduit, and produces a different mode of operation [Findings IX, R. 23; and Par. 6 of Statement of Points.]

5. In finding that, since the patented device and the accused device attain an old result of securing a conduit coupling there cannot be infringement although, in comparing the accused device and the patented device, that end result is obtained by means entirely different from the means used in the prior art [Finding X, R. 24; and Pars. 1 and 2 of Statement of Points].

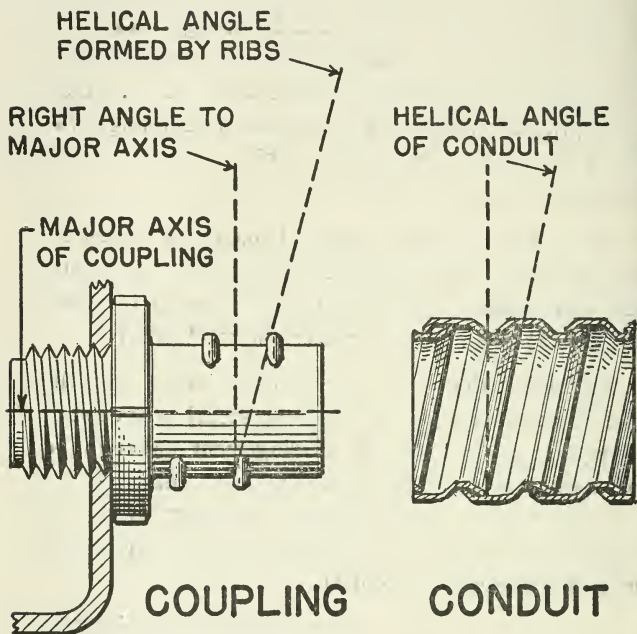
6. In failing to decree infringement and injunctive relief as to Exhibit 17 [Finding XI, R. 24; and Pars. 1-7 of Statement of Points].

7. In finding that the accused couplings have ribs which are at a 2° to 6° angle to the *longitudinal axis* of the coupling, and in finding that the accused devices do not have ribs substantially at right angles to the major axes of the couplings [Finding XIII, R. 25; and Pars. 1 and 7 of Statement of Points].

ARGUMENT OF CASE.

1. The Patent in Suit.

The coupling device of the patent in suit is illustrated by the following drawing:



It comprises a tubular member 1 whose inner end 9 is externally threaded so that it can be screwed in a journal box, as by a nut, and its outer end is provided with external ribs arranged in two groups, the top group consisting of two ribs and the bottom group consisting of two ribs. The ribs of the top group are staggered in relation to the ribs of the lower group and their relative spacing is such that a diagonal line drawn to intersect the end ribs will define a helical angle which is greater than

the helical angle defined by the spiral convolutions of the conduit into which the coupling is to be inserted. The helical angle of the spiral of the conduit is illustrated by a diagonal line intersecting like, but opposite, parts of any two contiguous convolutions of the conduit.

The helical angle formed by the ribs of the coupling, being greater than the helical angle of the convolutions of the conduit, it is possible, by rotation of the coupling device in one direction relative to the conduit, to insert the coupling in the conduit, because the ribs, by engaging the wall of the conduit, tend to unwind or axially extend the conduit (the conduit being axially expandable because its convolutions loosely engage each other), allowing passage of the ribs inwardly along the convolutions of the conduit. However, if rotation in the opposite direction is attempted, the ribs will be brought into jamming or gripping engagement with the inner surface of the conduit, because the conduit is then being axially constricted, or "wound up." (See Col. 3, lines 21-52, of the patent suit.)

The claim of the patent reads as follows:

"In a coupling for spirally wound, flexible conduits, a tubular member having means at one end adapted to be affixed to the wall of a junction box or the like, the other end of said coupling being insertable within the end of a conduit and having a series of ribs extending substantially at right angles to the major axis of said tubular member and adapted to engage the convolutions of the conduit, said ribs being sequentially disposed in staggered relation along the outer surface of the conduit-engaging portion of said coupling so as to define a spiral having a greater helical angle than the normal helical angle of the convolutions of the conduit."

Appellant's expert, Mr. Berry, testified from drawings of the patented couplings and of the accused couplings, as well as from the physical devices [Exs. 25-28, R. 192-195, Exs. 1-4, 17-22, 33, 34]. See his testimony as follows:

“Q. Now, what is the purpose of the spacing of the ribs which you have described relative to the helical angle formed by the convolutions of the conduit? A. It is manifestly for the purpose of effecting a wedge engagement between the ribs of the coupling and the internal channels of the conduit.

Q. Now, in order to obtain the free entry of the coupling into the conduit and then have it become locked in the manner which has been demonstrated here, what are the elements shown in those drawings which are essential to the operation? A. The relative spacing of the ribs, plus their greater helical angle relative to the helical angle of the spirals of the conduit.”

This was not controverted by appellees. It is clear, therefore, that the augularity of the ribs to the major axis is not critical.

2. All the Prior Art Offered by Appellees Was Considered by the Patent Office and Shows Nothing More Than Couplings Having Threads Mating With the Grooves of the Conduit.

There being no issue of validity involved in this appeal, no extended discussion of the prior art is necessary. However, the remoteness of the prior art [Ex. C] shows that it could not form the basis of any file wrapper estoppel and shows that the structure claimed by the patent in suit is broadly new.

The prior art offered by appellees was cited and considered by the Patent Office, and consists of the following patents, all included in the volume [Ex. C]:

Adamson	1,494,524
Wilson	1,629,058
Jacobi	1,973,170
Tiefenbacher	1,830,250
Hunter	1,775,128

Each of those patents shows conventional *threads* which *mate* with the spiral of the grooves of the conduit. Some of them show continuous threads and others show conventional interrupted threads. Interrupted threads are commonly used where it is desired to quickly thread two members together. That is, the male threaded member is inserted into the female threaded member until the threads are in alignment, and then the threads are meshed by simply turning the male member a half or quarter revolution [R. 152]. However, they do not effect any jamming or locking action.

It is to be noted that, in none of the prior art, is there any showing or suggestion of providing ribs and so spacing and staggering them *in relation to the spiral of the conduit* that they define a helical angle greater than the helical angle of the convolutions of the conduit.

Even if the interrupted threads of the prior art could be considered as “ribs,” still they lack the jamming or locking function provided by arranging them to produce this *greater* helical angle, so essential in the patented structure.

3. The Claim of the Patent in Suit Is Not Limited to the Coupling Having Ribs Extending Precisely at Right Angles to the Major Axis.

Appellant submits that there is no sound basis for the holding of the trial court that, in using the term “substantially at right angles to the major axis” in the claim of the patent in suit, the patentees precluded themselves from contending that the accused device, *which provides all the advantages of the invention*, avoids infringement by simply varying that angle by 1-5 degrees.

In writing the claim, the patentees were distinguishing the composite structure from couplings assemblies having *conventional mating threads*, and the statement must be construed in conjunction with the other elements of the claim, reading:

“said ribs being sequentially disposed in *staggered* relation along the outer surface of the conduit-engaging portion of said coupling so as to define a spiral having a *greater helical angle than the normal helical angle of the convolutions of the conduit*.”

As appellant's expert testified [R. 86], the essence of the novelty of the patent resides in this prescribed disposition of the ribs which produces this relatively greater helical angle; and the angular relation of the ribs to the major axis does not alter the helical angle which they form [R. 91].

There is nothing in the patent specification to indicate that there is anything critical in having the ribs disposed *precisely* or *essentially* at right angles.

The mere fact that the patentees stated that the ribs are disposed “substantially” at right angles, must presuppose that some tolerance or variation was intended.

The Law Relating to Use of Term "Substantially" in Patent Claims.

In fact, the word "substantially" is always implied in a patent claim, whether used or not, so as to give protection against minor technical departures.

Musher Foundation, Inc. v. Alba Trading Co., Inc., 150 F. 2d 885, 889.

In the latter case, Judge Learned Hand said:

" . . . 'substantially' is not of itself fatal to a claim; *Eibel Process Co. v. Minnesota & Ontario Paper Company*, 261 U. S. 45, 65: indeed it must always be implied in every claim, even when not introduced, and adds nothing when it is. Were this not true, few patents could give any protection for some departures from the precise disclosure are nearly always possible without losing the benefit of the invention. . . . Finally, 'substantially free of fibres' means 'filtered' or 'centrifuged' (p. 2, col. 1, lines 60, 61; lines 74, 75). It is impossible to suppose that anyone who really wishes to respect the patent would have any difficulty in identifying what the claim covered."

The Courts recognize that the word "substantially" is used in patent claims to prevent literal avoidance of infringement by minor changes.

Crosley Corp. v. Westinghouse, 52 Fed. Supp. 884 (D. C. W. D. Pa.).

A careful review of the decisions shows that the courts, practically unanimously, have interpreted use of the word "substantially" in patent claims as denoting that some tolerance or variation is intended, so long as it is not

enough variation to lose the benefits of the inventive concept.

- Moss v. Patterson-Ballagh Corp.*, 89 Fed. Supp. 619, 627, Affd. 201 F. 2d 403 (9th Cir.);
Bianchi v. Barili, 168 F. 2d 793, 799 (9th Cir.);
Application of Curley, 158 F. 2d 300, 304 (C. C. P. A.);
Engineer Co. v. Hotel Astor, 226 Fed. 779, 781, (D. C. S. D. N. Y.);
Hazeltine Corporation v. A. H. Grebe & Co., 21 F. 2d 643, 645 (D. C. E. D. N. Y.);
Pittsburgh Iron & Steel Foundries Co. v. Seaman-Sleeth Co., 236 Fed. 756 (D. C. W. D. Pa.);
Robins v. Wettlaufer, 81 F. 2d 882, 892 (C. C. P. A.);
Stubnitz-Greene Spring Corp. v. Fort Pitt Bedding Co., 110 F. 2d 192, 198 (6th Cir.).

Appellees have not made any showing whatsoever to the effect that the slight variation of the angle of their ribs from the right angular produces any difference in operation. Appellant's expert testified [R. 91] that the only difference it could possibly make would be to cause the ribs to engage the walls of the conduit convolutions *a moment quicker*. That, however, only affects the relative efficiency of the accused devices, not their mode of operation.

4. There Is No File Wrapper Estoppel.

Findings VIII [R. 22] and XII [R. 25] disclose that the trial judge based his ruling of non-infringement upon his own interpretation of the file wrapper of the patent in suit [Ex. D].

Those findings also indicate that the trial judge based his holding upon his interpretation of the file wrapper

proceedings relating to claim 2 of the application (which matured as the claim of the patent), and claim 10 of the application, which was canceled.

Analysis of the file wrapper discloses the following facts: In its first action, the Patent Office held that the application showed and claimed three different inventions and required division. In the first response by the patentees, they canceled most of the claims because of the requirement for division, and amended claim 2, as follows: In its original form, claim 2 merely referred to the ribs as "radially extending," which was amended to read that the ribs extended "substantially at right angles to the major axis." Also, as originally filed, claim 2 did not recite the staggered relationship of the ribs, and was amended to recite said staggered relationship. With that amendment, the patentees presented the following argument:

"Claim 2 as amended is believed to be allowable in defining the tubular member as having a series of ribs extending substantially at right angles to the major axis thereof and disposed in staggered relation to define a spiral having a greater helix angle than the normal helix angle of the conduit."

In the next Patent Office action, claim 2 was *allowed* and claim 10 was rejected. In responding to that action, the patentees amended claim 10 to read as follows:

"10. A device for providing an end of a spirally wound, flexible conduit with a means of attachment to an object comprising, a tubular member having means at one end adapted to be connected to said object and means at the other end adapted to be interiorly engage a plurality of convolutions of said conduit and incident to such engagement to effect a

stretching action between adjacent convolutions so engaged, said last named means including a series of ribs on the exterior of said tubular member adapted to engage the convolutions of the conduit, and define a spiral having a greater helical angle than the normal helical angle of the convolutions of said conduit.”

It will be observed that said claim 10 was couched largely in terms of *function* and failed to recite the staggered arrangement of the ribs so necessary to cause them to define a helical angle greater than that of the conduit. Nor did it recite the substantially right angular arrangement of the ribs. *If it had been amended to specify these structural elements, it would have been in substance the same as claim 2 which had already been allowed.*

In the next Patent Office action, said claim 10 was again rejected and was then canceled, the patent being passed to issue with the allowed claim 2.

Nowhere in the prosecution of the application for the patent was anything said which signified that the term “substantially at right angles” in the claim had any critical significance; and nowhere was it argued, as recited in finding VIII, that the only novelty in the claim was the substantially right angular disposition of the ribs. The Patent Office never at any time criticized or interpreted the use of the term “substantially.”

As shown by the oral opinion [R. 167], in making its interpretation of the file wrapper, the trial court cited, as authority, the case of *Schnitzer v. California Corrugated Culvert Co.*, 140 F. 2d 275 (9th Cir.). However, an examination of the opinion in that case shows that the facts were not at all analogous to those of the instant case. There, the patent was for a combination of elements one of which was a packing specified in the claim

s having a flange frictionally retained in a groove, the engagement of the flange in the groove serving to retain it in place. Such a packing was known as a "hat" packing because the flange was similar to the brim on a hat. However, in the accused device there involved, a U- or V-shaped packing was used which had no such flange and which was held in place by the pressure of the water upon the two lips of the V. The evidence in the case showed that there was a generally recognized material distinction between "hat" packings and U or V packings. The file wrapper of the patent involved showed that, to overcome rejection of the patent claim, the patentee argued to the effect that a prior art patent (which showed a U-shaped packing) did not show a packing having a flange clamped in a groove, and avoided the rejection by this argument. Consequently, the patentee there was clearly estopped to contend that the U-shaped packing used by the defendant, and having a counterpart in the prior art, was the equivalent of a packing having the flange as specified in the patent claim.

5. The Accused Devices Infringe.

The accused devices are in evidence as Exhibits 17-22, 33 and 34 and are compared with the patented couplings in drawing Exhibits 25-28 [R. 192-195]. They are all substantially the same, except for size.

Those exhibits, and the testimony of appellant's expert, Mr. Berry, show that the accused devices have ribs which vary from the right angular (to the major axis) by only 1 to 5 degrees, and which are sequentially disposed in staggered relation along the outer surface of the coupling so as to define a spiral having a greater helical angle than the normal helical angle of the convo-

lutions of the conduit. There is no issue as to what is meant by a “normal” conduit [see Finding IX, R. 23].

Appellant’s expert testified that the relative spacing of the ribs, and the helical angle formed by the spacing in relation to the conduit, are the same as in the patented couplings [R. 86, *et seq.*]; that the ribs of the accused devices are substantially at right angles to the major axis (the slight variation from the right angular not affecting the function or mode of operation) [R. 93]; and that the accused devices and the patented device function in the same manner [R. 91]. He further testified that the only possible effect of the slight variation from the right angular in the disposition of the ribs of the accused devices would be that the ribs could possibly engage the wall of the conduit slightly quicker, which, however, does not affect the mode of operation [R. 91].

Appellees offered no evidence to contradict this showing. Appellees’ only witness, Mr. Friedman, testified that because the ribs of the accused devices are slightly thicker than the ribs of appellant’s *commercial product*, they get a “better grip”; but Mr. Friedman concedes that he was not an engineer and could only guess as to how the accused devices function [R. 122-123]. Moreover, as pointed out hereinbefore, the claim of the patent in suit does not specify any particular thickness of the ribs, and, in any event, it does not avoid infringement to make an accused device more or less efficient than a patented device.

Matthews v. Allen, 182 F. 2d 824, 828 (4th Cir.);

Weiss v. R. Hoe & Co., 109 F. 2d 722, 726 (2d Cir.);

Angelus Sanitary Can Mach. Co. v. Wilson, 7 F. 2d 314, 318 (9th Cir.).

FINDING IX.

There is *no* evidence to support finding IX [R. 23], to the effect that “the outside diameter of defendants’ couplings is greater than the inside diameter of the normal conduit” causing the defendants’ coupling to operate in a mode different from plaintiff’s. It may be that this relates to the testimony of Mr. Friedman that the accused couplings were thicker and thus obtained a “better grip,” but as pointed out hereinbefore, that does not affect the mode of operation.

FINDING XIII.

Also, Finding XIII [R. 25], to the effect that the ribs on the accused devices are at 2° to 6° angle to the *longitudinal axis* of the couplings, is directly contrary to the evidence. See Exhibits 17-22, 33, 34 and Exhibits 25-28. What that finding probably intended was that said ribs were *oriented from the right angular* by 2° to 6°. That part of the finding which recites that the accused couplings do not have ribs disposed “substantially at right angles” to the major axis is contrary to law and contrary to the undisputed testimony of appellant’s expert, is hereinbefore pointed out.

This Court, in discussing infringement in *Bianchi v. Marili*, 168 F. 2d 793, 801 (9th Cir.), said:

“It is also a question of substance, and not of nomenclature. It is not to be settled by striving to ascertain the difference between tweedledum and tweedledee.

“In *Hydraulic Press Mfg. Co. v. Williams, White & Co.*, 7 Cir., 165 F. 2d 489, 492, the court said:

“In determining the question of infringement, the court is not to judge about similarities or differences

by the names of things, but is to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it. [Case cited]

* * * One does not escape infringement by providing a single element which fully responds to a plurality of elements in the patent. [Case cited]'

"So here, Bianchi did not escape infringement by putting all his cutters on one roller, for he thereby was 'providing a single element which fully responds to a plurality of elements [*i. e.*, two cutting rollers] in the patent'. Indeed, as we have already noticed, Bianchi himself conceded that the rollers can be put 'any way you want to.'

"Nor need the substantial indentity between the two machines be demonstrated to a mathematical certainty. In *City of Grafton, W. V., v. Otis Elevator Co.*, 4 Cir., 166 F. 2d 816, 821, the following language was used:

"'Rarely do we find an example of what might be called perfect infringement. No patent infringer would be so silly as to make and vend a device similar in every minute detail to a patent. Infringement connotes, between the patent and the accused device, merely correspondence as to the substantial, dominate and essential elements. Any other view would make of a patent a foolish and fatuous thing.'"

See also:

Pointer v. Six Wheel Corp., 177 F. 2d 153, 162 (9th Cir.);

Sanitary Refrigerator Co. v. Winters, 280 U. S. 30, 74 L. Ed. 147.

The Doctrine of Equivalents.

Even if, because of the use of the word “substantial” in the patent claim, it could properly be said that the accused devices are not strictly within the language of the claim, still it is the policy of the courts to preserve to patentees the benefits of their inventions by applying the doctrine of equivalents. As said in *Graver Tank Co. v. Linde Air Products Co.*, 339 U. S. 605, 94 L. Ed. 1097, 1101:

“In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it.

“But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copy-righted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.

“The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of *Winans v. Denmead* (US) 15 How 330, 14 L ed 717, it has been consistently applied by this Court and the lower federal courts, and continues today ready and available for utilization when the proper circumstances for its application arise. ‘To temper unsparing logic and prevent an infringer from stealing the benefit of the invention’ a patentee may invoke this doctrine to proceed against the producer of a device ‘if it performs substantially the same function in substantially the same way to obtain the same result.’ *Sanitary Refrigerator Co. v. Winters*, 280 US 30, 42, 74 L ed 147, 156, 50 S Ct 9.”

Conclusion.

Appellant respectfully submits that since the patent in suit has been declared valid, and since the holding of non-infringement is predicated upon findings unsupported by the evidence, the judgment should be reversed.

Respectfully submitted,

MASON & GRAHAM,

COLLINS MASON,

WILLIAM R. GRAHAM,

Attorneys for Appellant.